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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,236	01/19/2006	Etienne Annic	5284-59PUS	6639
27799 7590 08/19/2008 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER CHRISTENSEN, SCOTT B				
ART UNIT		PAPER NUMBER		
2144				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/537,236

**Applicant(s)**

ANNIC, ETIENNE

**Examiner**

Scott Christensen

**Art Unit**

2144

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 5/31/2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action is in regards to the most recent papers filed on 5/31/2005.

***Response to Amendment***

2. The amendment filed 5/31/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: References to documents cited in the international search were included in the amendments to the specification, with descriptions and comparisons of the documents with the instant application.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Information Disclosure Statement***

3. The information disclosure statement filed 5/31/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. This is relevant to the Non Patent Literature Document by M. Bilgic et al.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for selection means in combination with other component, does not reasonably provide enablement for every possible selection means and their equivalents, as in 112 6<sup>th</sup> paragraph. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make use of the invention commensurate in scope with these claims.

According to 35 USC 112 6<sup>th</sup> paragraph, "An element in a claim for combination may be expressed as a means or step for performing a specified function. However, in the instant case, the selection means is the only element claimed as being part of the system (See also MPEP 2164.08(a)). It is noted that 112 6<sup>th</sup> paragraph also sets forth that this must be done "without the recital of structure, material, or acts in support thereof." However, the claim sets forth structure and acts in support of the selection means. Therefore, it appears that the selection means, as claimed in claim 9, should be rewritten in such a way as to not attempt to invoke 112 6<sup>th</sup> paragraph, or be rewritten to fully comply with the requirement as set forth in 112 6<sup>th</sup> paragraph.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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7. Claims 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to claim 9, the instant claim is directed towards a system that comprises selection means. However, selection means appear to be directed towards software alone, as it appears that the selection is performed by a program that is executed by a computer processor. For a system claim to be statutory, it must be directed towards a system of software and hardware or hardware alone, but not software. Further, for a claim to be found statutory, each and every embodiment within the scope of the claim must be statutory. In the instant case, it appears that there is at least one embodiment of the instant claim that is directed towards nonstatutory subject matter. Claims 10-15, which depend from claim 9, are rejected for the same.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 9-16 are rejected under 35 U.S.C. 102(e) as being anticipated by WO

02/01822 A1 to Lantto et al., hereafter referred to as "Lantto."

With regard to claim 9, Lantto discloses a system for making a selection from a set of architectures dedicated to communications networks in a terminal that includes a user interface and is adapted to be connected simultaneously to a plurality of said communications networks which system is characterized in that the connections to the communications networks being set up via a mobile network by means of a PDP context links to said communications networks, the system comprises

selection means integrated into the user interface of the terminal

for selecting the APN of one of the communications networks (Lantto: Page 16, lines 16-32 and page 17, lines 1-6. The computer passes parameters including APN, meaning that the APN is selected by the computer.),

for controlling access to a dedicated architecture manager integrated into the terminal for managing the architecture dedicated to the selected communication network (Lantto: Page 17, lines 23-29. The computer processor controls the operations of the system of Lantto, including access to the communication networks and managing the architecture dedicated to the communication network.), and

for connecting the dedicated architecture manager to the PDP context link to the selected communication network in order to process a state of said link and to adapt a resource to the selected communication network (Lantto: Page 10, lines 16-21).

With regard to claim 10, Lantto discloses that the dedicated architecture manager includes means for controlling, separately or in combination, creation, modification, suspension and closure of a dedicated architecture, according to the management function selected by the selection means (Lantto: Page 17, lines 23-29. First, it is noted that the dedicated architecture manager is not claimed as being part of the system, but rather the system interacts with the architecture manager. Therefore, limitations to the architecture manager have questionable weight. However, the computer of Lantto is fully capable of performing each and every one of these claimed functions.).

With regard to claim 11, Lantto discloses that the dedicated architecture manager manages all of the dedicated architectures, which, in order to maintain the independence of the various communication networks, have no functions for managing PDP context links (Lantto: Page 17, lines 23-29. The computer processor manages all of the dedicated architectures.).

With regard to claim 12, Lantto discloses that the selection means are associated with a selection means control device (This limitation is inherent, as in order for the selection means to function, the selection means must either be on some device or be a device, both of which would constitute a selection means control device.).

With regard to claim 13, Lantto discloses that, as a function of the selection means, the dedicated architecture manager is connected to a first transmission means

for managing transmissions using a dedicated architecture of the terminal (Lantto: Page 17, lines 23-29. The computer processor includes connections to the other components of the computer, including the network interface.).

With regard to claim 14, Lantto discloses that, as a function of the selection means, the dedicated architecture manager is connected to a second transmission means for managing transmission to the selected communications networks (Lantto: Page 17, lines 23-29. The computer processor includes connections to the network interface, which is connected to the external network.).

With regard to claim 15, Lantto discloses that, as a function of the selection means, the dedicated architecture manager is connected to a resource of the terminal accessible by a dedicated architecture (Lantto: Page 17, lines 23-29. The computer processor is connected to each resource of the terminal.).

With regard to claim 16, claims 16 is substantially similar to the invention claimed in claims 9-15, and is rejected for substantially similar reasons.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Christensen whose telephone number is (571)270-1144. The examiner can normally be reached on Monday through Thursday 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/  
Primary Examiner, Art Unit 2144

/S. C./  
Examiner, Art Unit 2144